

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

OCT 27 2003

Ex parte JOHN W. MERILL

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2001-2630
Application 09/115,359

ON BRIEF

Before JERRY SMITH, BLANKENSHIP and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 14, 15 and 21-32, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for responding to a computer user's inputs to a

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computer. More particularly, the invention relates to a software object in an object oriented programming environment which responds to both spoken and non-spoken command information.

Representative claim 14 is reproduced as follows:

14. A method for responding to user inputs to a computer comprising:

providing a software object that receives spoken and non-spoken command information; and

firing an event when an object receives command information.

The examiner relies on the following references:

| | | |
|------------------------------|-----------|----------------------|
| Hashimoto et al. (Hashimoto) | 5,632,002 | May 20, 1997 |
| Trower, II et al. (Trower) | 5,983,190 | Nov. 09, 1999 |
| | | (filed May 19, 1997) |

Adam Denning, ActiveX Controls Inside Out, Microsoft Press, 1997.

The following rejections are on appeal before us¹:

1. Claims 14, 15, 25-27 and 29-32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Trower.

2. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Trower in view of Denning.

¹ The rejection of claims 26 and 30 under the second paragraph of 35 U.S.C. § 112 has been withdrawn by the examiner [answer, page 11].

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3. Claims 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Hashimoto taken alone.

4. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings Hashimoto in view of Denning.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports each of the examiner's rejections. Accordingly, we affirm.

We consider first the rejection of claims 14, 15, 25-27 and 29-32 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Trower. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). These claims will stand or fall together as a single group because appellant has made the same argument with respect to each of the claims within this group.

With respect to representative, independent claim 14, the examiner has indicated how he finds the claimed invention to be met by the disclosure of Trower [answer, pages 5-6]. Appellant argues that Trower does not teach an object that receives both spoken and non-spoken command information. Specifically, appellant argues that the object in Trower may respond to one or the other but not both [brief, pages 8-9]. The examiner responds that the spoken and non-spoken inputs in Trower are clearly

received in parallel. The examiner also notes that Trower refers to cursor input and speech input [answer, page 11].

We will sustain this rejection of claims 14, 15, 25-27 and 29-32. We find that the disclosure of Trower discloses to the artisan that the computer responds to spoken and non-spoken command information as recited in representative claim 14. For example, Trower discloses that "clients can specify input commands including both speech and cursor device input for the character" [column 2, lines 29-31]. Trower also discloses that the "server monitors input from the operating system (cursor input device) and the speech recognition engine (speech input) for this input" [id., lines 65-67]. Finally, claim 2 of Trower, which depends from claim 1, recites that the set of client specified user input commands comprises cursor input from a cursor control device (claim 1) and further comprises speech input received through a speech recognition engine (claim 2). Each of these portions of Trower discloses to the artisan that Trower is intended to respond to spoken and non-spoken command information as recited in claim 14.

We now consider the various rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

With respect to the rejection of claim 28 based on the teachings of Trower and Denning, appellant has offered no response to this rejection. Since we find that the examiner has at least established a prima facie case of the obviousness of claim 28, and since appellant has not responded to this rejection on the merits, we sustain the rejection of claim 28 for the reasons discussed above and for the reasons noted by the examiner.

We now consider the rejection of claims 21-23 based on the teachings of Hashimoto. The examiner has explained how he finds the claimed invention to be obvious over the teachings of Hashimoto [answer, pages 8-10]. These claims will stand or fall together as a single group because appellant has made the same argument with respect to each of the claims within this group. With respect to representative claim 21, appellant argues that the examiner's assertion that the same identifier is associated with the spoken and non-spoken command is not supported by the reference. As a result, appellant argues that the examiner has failed to establish a prima facie case of obviousness. Appellant points to Figure 17 of Hashimoto as evidence that Hashimoto does use the same identifier for spoken and non-spoken commands [brief, pages 9-11].

The examiner responds that Figure 96 of Hashimoto and its corresponding description teaches that the speech recognition result is converted into a format which is identical to those generated at the time of the operation command inputs by the usual input devices such as the keyboard and the mouse. The examiner therefore reiterates that the spoken and non-spoken commands in Hashimoto are associated with the same identifier as recited in representative claim 21 [answer, pages 11-12].

We will sustain the rejection of claims 21-23 for essentially the reasons argued by the examiner. Although appellant's arguments with respect to Figure 17 of Hashimoto are correct, Figure 17 is only one of several embodiments disclosed in Hashimoto. The examiner points to Figure 96 of Hashimoto which corresponds to a completely different embodiment of Hashimoto's invention. Hashimoto discloses that the SIM 104 in Figure 96 converts speech inputs into a form acceptable by the general application program (GAP) 103 such as that of the mouse or keyboard inputs [column 59, lines 54-58]. As noted by the examiner, Hashimoto also indicates that the identifier associated with the spoken and non-spoken commands must be the same because the message conversion unit 143 generates speech recognition commands which are identical to those of the keyboard and the mouse [column 60, lines 17-23]. Therefore, we find that Hashimoto teaches at least an embodiment in which the same identifier is associated with spoken and non-spoken commands as claimed by appellant.

With respect to the rejection of claim 24 based on the teachings of Hashimoto and Denning, appellant has offered no response to this rejection. Since we find that the examiner has at least established a prima facie case of the obviousness of

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claim 24, and since appellant has not responded to this rejection on the merits, we sustain the rejection of claim 24 for the reasons discussed above and for the reasons noted by the examiner.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 14, 15 and 21-32 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Howard B. Blankenship

HOWARD B. BLANKENSHIP
Administrative Patent Judge

Mahshid D. Saadat

MAHSHID D. SAADAT
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